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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/606,688 | 06/26/2003 | Diana Clifton Draper | BD59/05 | 6279 |

7590 03/02/2004
Edward P. Dutkiewicz
P.O. Box 511
Largo, FL 33779-0511

EXAMINER

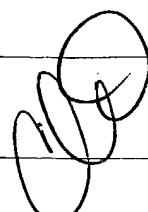
PRICE, CARL D

ART UNIT PAPER NUMBER

3749

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/606,688 | Applicant(s) DRAPER ET AL. | |
| | Examiner CARL D. PRICE | Art Unit 3749 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Numbering

The original "type" written numbering of claims 1,2 and 4-7 is not in accordance with 37 CFR 1.126 which requires claims to be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented. It is noted that originally type written claims 4-7 have been renumbered as claims 3-6. No claim numbered claim "2" was originally filed.

§ 1.126 Numbering of claims

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

Specification

The disclosure is objected to because of the following informalities:

On page 1, in the first paragraph, of the specification the information referencing applicants' co-pending application must be updated.

Appropriate correction is required.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, **unless** the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84 because a reference character has not been used to reference the small hole appearing in Figure 4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

Applicant has failed to include a reference character to reference the small hole appearing in Figure 4.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6: rejected under 35 U.S.C. 112, second paragraph

Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are vague and indefinite. For example, in claim 2 in line 5, there is no proper antecedent basis for "the second diameter" See also claims 3-6 which include "the second diameter".

The term "upward" in claim 1 is a relative term rendering the claim indefinite. The term "upward" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In claims 3-6 the phrase "the safety cover having a diameter sized to fit securely within the second diameter of the lower skirt" is redundant with the same language found in claim 2 from which they depend. Similarly, in claims 3,5 and 6 the phrase "and a Z-shaped upward projection coupled to the cover with the projection having a notch at an uncoupled end" is also redundant with the same language of claim 2 from which they depend.

Double Patenting: 35 U.S.C. 101

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1: rejected under 35 U.S.C. 101

Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 10/606,695. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Nonstatutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1: rejected under Double Patenting

Claim 1 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,688,877 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 1 of U. S. Patent No. 6,688,877 differs from claim 1 of the present application only by the inclusion of the term "methanol" as the quantity of combustible liquid. The more narrowly defined invention set forth in claim 1 of U. S. Patent No. 6,688,877 would therefore anticipate, if patented, the more broadly recited "a quantity of combustible liquid to be used as the fuel" of the present application claim.

Claims 2-6: rejected under Obviousness-type Double Patenting

Claims 2-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,688,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 1 of U.S. Patent No. 6,688,877 includes numerous limitations the more narrowly defined invention set forth in claim 1 of U. S. Patent No. 6,688,877 would anticipate, if patented, the more broadly recited safety cover of claims 2-6. The plurality of holes claimed in U.S. Patent No. 6,688,877 being the structural and functional equivalent to applicant's "plurality radially spaced discontinuities".

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(Claim 1 of U.S. Patent No. 6,688,877):

a safety cover having a round flat disc-like configuration with **a plurality of holes** there through, the safety cover having a diameter sized to fit securely within the second diameter of the lower skirt, the cover having a Z-shaped upward projection coupled thereto, the projection having a notch at the uncoupled end;

(Claim 2 of the present application)

the safety cover having a round disc-like configuration, a plurality radially spaced **discontinuities of various sizes** provided through the cover, safety cover having diameter sized to fit securely within the second diameter of a lower skirt, and Z-shaped upward projection coupled to the cover with the projection having a notch at an uncoupled end.

In addition, while claims 2-6 of the present application defines the discontinuities as 1) a plurality radially spaced discontinuities of various sizes provided through the cover, 2) plurality apertures various shapes provided through ovals least one circle, 3) a plurality of small holes and at least one large hole, plurality of dimples, etc., it would have been an obvious matter of design choice to modify claim 1 of U.S. Patent No. 6,688,877 to include the various forms of discontinuities set forth in applicant's claims 2-6, and a person having ordinary skill in the art would have expected Applicant's invention to perform equally well with holes of any shape or arrangement. Applicant has not disclosed that the various forms of discontinuities provide an advantage, is used for a particular purpose, or solves a stated problem. Thus, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the discontinuities, for example, as 1) a plurality radially spaced discontinuities of various sizes provided through the cover, 2) a plurality apertures various

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shapes provided through ovals least one circle, 3) a plurality of small holes and at least one large hole, plurality of dimples, etc.

Conclusion

See the attached PTO FORM 892 for prior art made of record and not relied upon and which are considered pertinent to applicant's disclosure.

USPTO CUSTOMER CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is 703-308-1953. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703-308-1935. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CARL D. PRICE
Primary Examiner
Art Unit 3749

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